

REMARKS

Status of Claims

Claims 1-25 are pending in this application. Applicant has not amended the claims and no new matter has been added. The following remarks are presented in support of the patentability of the pending claims.

Amendments to Specification

The Office objected to the specification as to Tables 3 and 4 on pages 17 and 18 and requested appropriate correction. See Final Office Action at 2. Applicant has amended the specification by deleting Tables 1, 3, and 4 and presented new Tables 1, 3, and 4 in full. These amendments do not add new matter as the amendments are supported by the foreign priority document for this application, GB02192565. A copy of GB 0219256.5 is attached, which includes tables 1, 3, and 4 in full.

Rejections under 35 U.S.C. § 103(a)

The Office issued multiple rejections for claims 1-25 under 35 U.S.C. § 103(a). Applicant respectfully traverses each of those rejections below.

Lyons and Golley

The Office maintained its rejection of claims 1, 3-4, 6-7, 10-11, 13, and 20-25 under 35 U.S.C. § 103(a) as allegedly obvious over WO 00/66510 ("Lyons") in view of WO 00/59840 ("Golley"). *Id.* As stated in Applicant's Response dated July 10, 2007, Lyons and Golley, whether taken alone or in combination, do not teach or suggest the

shape factor range set forth in the amended claims and cannot form the basis for a proper *prima facie* case of obviousness.

Neither Lyons not Golley teach a shape factor range of from about 26 to about 40, as set forth in independent claims 1 and 14. The Office has alleged that the recited term “about” is unclear and that a shape factor of 25 or less reads on “about 26.”¹ See Final Office Action at 8. Applicant respectfully traverses.

Claim terms must be given their plain meaning unless a different definition is provided in the specification. See MPEP § 2111.01. The plain meaning of “about” includes values that the skilled artisan would consider as encompassed within reasonable approximations and ranges that could and would be applied to a given value. In this case, the skilled artisan would understand that a shape factor of “about 26” does not encompass a shape factor of 25 or less. Therefore, the skilled artisan would readily understand that the cited references do not teach or suggest the claim shape factor range; moreover, nothing in those references would have provided any motivation or suggested the desirability of increasing the shape factor range in an effort to achieve products and methods of the pending claims. For that reason alone, this obviousness rejection is improper and should be withdrawn.

¹ Applicant notes that the Office has not made any rejection of the claims under 35 U.S.C. § 112, second paragraph, in regards to the term “about.” Such a rejection would indeed be improper as the term is readily definite and clear to the skilled artisan in the context of the pending claims and the disclosed subject matter. Applicant does clarify herein, however, that the recitation of “about 26” does not encompass “25 or less.”

Lyons and Golley in view of Johns and Golley in view of Johns

The Office previously rejected claims 8-12 as obvious over Lyons and Golley in view of U.S. Patent Application Publication No. 2004/0250973 A1 ("Johns I"), which allegedly describes a steepness of at least 32 and a shape factor of at least 30. In the Final Office Action, the Office rejected claims 8-12 as obvious over Lyons and Golly in view of WO 02/16511 ("Johns II"). *Id.* at 3. The Office supplemented the Final Office Action by also rejecting claims 14-16 and 18 as allegedly obvious over Golley in view of Johns II, which also purports to also describe not more than 10% by weight having a particle size less than 0.25 μm . *Id.* at 4-5. Johns I is the published U.S. national stage application of PCT/GB01/03717, which published as Johns II. Accordingly, Johns I and Johns II have the same specification and will be collectively referred to herein as "Johns". Applicant respectfully traverses the rejections for at least the reasons that follow and for the additional reasons given in the response dated July 10, 2007.

The Office alleges that it would have been obvious to modify Lyons and Golley to include the steepness and shape factor parameters disclosed by Johns because of the improved properties of its products. *See* Final Office Action at 4-6. However, neither Lyons nor Golley teach or suggest the shape factor and steepness recited in the pending claims. The references' disparate teachings on shape factor also point to a lack of any motivation or suggestion of the desirability to make the Office's proposed combination, as Lyons appears to teach a shape factor of less than 25 and Golley appears to teach a shape factor of at least 50. Both references are also silent regarding shape factors from about 26 to about 40, which is recited in the pending claims. That Johns may disclose a shape factor of at least 30 does not remedy any of those

deficiencies, because none of the references teach or suggest any desirability to combine their various disclosures in light of the different ranges taught for shape factors. Though Johns and Golley could potentially overlap in their ranges, those two references by themselves could not support a *prima facie* case of obviousness and, indeed, the Office has not made such an assertion. Thus, no reasonable combination of the cited references would have resulted in the subject matter of the pending claims.

Applicant respectfully notes that the Office misstates Golley when it says that the reference discloses a "shape factor increase by at least 10 or 15." *Id.* at 5. Although Applicant agrees with the Office's ultimate conclusion that Golley does not disclose the steepness or shape factor of the pending claims,² Golley states at page 13, lines 26-27, that "the shape factor is increased from about 15 to 25 to at least 50." Therefore, if anything, Golley may teach or suggest a shape factor increase of at least 25 to 35, not an increase of at least 10 or 15 as alleged by the Office.

The Office also alleges that Johns discloses a particle size distribution in which less than 10% has a particle size of less than 0.25 μm and that this reads on "about 15% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25 μm ," as recited by claim 14. See Final Office Action at 5. Again, in making its rejection, the Office alleged that the term "about" is unclear. As stated above, the plain meaning of "about" includes values that the skilled artisan would consider as encompassed within reasonable approximations and ranges that he could

² Applicant further notes that in the Final Office Action at p. 9, the Office withdrew its rejection in light of similar arguments made by Applicant.

and would apply to a given value. The skilled artisan would readily understand that "about 15% to about 20% by weight" does not encompass less than 10%.

In sum, the skilled artisan would not have been motivated to combine Johns with either Golley or Lyons, and further, none of these references either separately or in combination support a *prima facie* case of obviousness over the pending claims. For at least those reasons, Applicant respectfully requests that these rejections be withdrawn.

Lyons and Golley in view of Willis or Yuan; Golley and Johns in view of Bown or Shi

The Office maintained its rejection of claim 2 under 35 U.S.C. § 103(a) as obvious over Lyons and Golley in view of U.S. Patent No. 5,169,443 ("Willis"), which allegedly teaches crude secondary kaolin from the Para region of Brazil. Also maintained was the rejection of Claim 5 as obvious over Lyons and Golley in view of WO 00/32699 ("Yuan"), which the Office believes to teach an e.s.d. of less than 0.25 μm for about 17.8% weight of the particles. Previously, the Office rejected claim 17 under 35 U.S.C. § 103(a) as allegedly obvious over Lyons and Golley in view of U.S. Patent No. 6,003,795 ("Bown"), which allegedly teaches a multi-stage grinding process. In the Final Office Action, the Office issued a new rejection of claim 17 under 35 U.S.C. § 103(a) as allegedly obvious over Golley and Johns II in view of Bown. Likewise, the Office previously rejected claim 19 as allegedly obvious over Lyons and Golley in view of U.S. Patent No. 5,089,056 ("Shi"), which the Office believes teaches the use of a water-soluble bleaching agent. In the Final Office Action, the Office newly rejected claim 19 as allegedly obvious over Golley and Johns II in view of Shi. *See generally* Final Office Action at 2-3 and 6-7. Applicant respectfully traverses those rejections.

As stated in the July 10, 2007 response, in the very least, neither Willis, Yuan, Bown, nor Shi remedy the deficiencies of Lyons or Golley regarding the non-disclosure of the recited shape factor in the range of from about 26 to about 40. For at least that reason, the addition of the cited secondary references to Lyons and/or Golley does not support the *prima facie* obviousness of claims 2, 5, 17, and 19.

The rejections are also inappropriate as the Office attempts to fill the gaps between Lyons and Golley and the present invention by cherry-picking specific properties discussed in the secondary references. That kind of piecemeal assemblage ignores the fact that, to support a *prima facie* case of obviousness, the skilled artisan must have had some reason to combine the noted elements in the same way as the recited inventions. Indeed, the MPEP cautions that “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143 (emphasis in original). In addition, even if the skilled artisan would have been motivated to combine the primary references with any one of the secondary references in order to obtain the subject matter recited in the pending claims, it is not permissible to pick and choose properties from various references and assume that the skilled artisan would know how to achieve the desired product having a specific combination of properties, as a reasonable expectation of success is generally required to support a *prima facie* case of obviousness. See MPEP § 2143.02. Without some suggestion of the desirability or a clear motivation to achieve the subject matter of the claims, the Office’s combination relies on impermissible hindsight and lacks any proper basis for the rejection.

In all, Applicant submits that the Office has not established that the noted combinations of references would have rendered the subject matter recited in the pending claims obvious to one of ordinary skill in the art. Accordingly, Applicant respectfully requests that the Office withdraw its rejections under 35 U.S.C. § 103.

Conclusion

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Office, placing claims 1-25 in condition for allowance. This Amendment should allow for immediate action by the Office. Furthermore, Applicant respectfully points out that the Final Office Action presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance. Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that the subject matter recited in the pending claims is neither anticipated nor rendered obvious in view of the cited references. Applicant therefore requests the entry of this Amendment, the reconsideration and continued examination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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